

REMARKS

Claims 1-24 are pending in this application. No amendments are made.

Claim Rejection Under 35 U.S.C. §102

Claims 1, 2, 4, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwato *et al.* (US2003/0143481). Applicants respectfully traverse.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *See* MPEP 2131 (*citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP 2112 (*citing Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)). Finally, to make an anticipation rejection, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *See* MPEP 2131 (*citing Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

It is respectfully submitted that the examiner has not identified each and every element of claims 1, 2, 4, and 13 in the prior art. Independent claims 1 and 13, *inter alia*, require transparent substrate film and a surfactant having an HLB in the range of 2 to 12.

The invention of Iwato *et al.* relates to a positive light-sensitive image forming material for infrared lasers, and it is a new image forming material used for a CTP (Computer-To-Plate) system. Since the image forming material of Iwato *et al.* is a positive type, a portion irradiated by infrared lasers (exposed portion; non-image portion) shows solubility in an alkali developing solution, and unexposed portion (image portion) does not show solubility in the alkali developing solution (see [0004] and [0014] in Iwato *et al.*). This is because, due to an effect of a light-heat converting agent, light energy created by irradiation in the exposed portion is converted to heat, and the heat dissolves an interaction between a compound represented by the general formula (1) and a binder polymer, and further dissolves dissolution inhibitive ability (inhibition).

Iwato *et al.* fails to expressly disclose a transparent substrate film. The examiner points to paragraph [0198] for the alleged disclosure of a polyester substrate film. The examiner does not state that the polyester film is transparent, nor provides evidence that the polyester film is inherently transparent. Iwato *et al.* indicates that “[e]xamples of the substrate used in the invention include dimensionally stable plate materials.” Iwato *et al.* discloses that the substrate is “preferably a polyester film or an aluminum plate.” See paragraph [0199]. Iwato *et al.* does not disclose that the transparency of the film. Thus the limitation is not expressly disclosed. Furthermore, the examiner has stated no rationale why the disclosed polyester film is inherently transparent. If an examiner is to rely upon the theory of inherency, he or she must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. The examiner has provided no basis in fact and/or technical reasoning that a transparent polyester film would be used as a “dimensionally stable” printing plate. Withdrawal of this ground of rejection is thus respectfully requested.

As an additional ground for withdrawal, it is noted that the examiner has failed to identify the use of a surfactant having an HLB of between 2 to 12. In the embodiment of the present invention disclosed in independent claims 1 and 13, a surfactant having an HLB in a range of 2 to 12 is contained at 0.01% to 2.0% by mass in the composition. The reasons of these limitations are described as follows.

By adding a surfactant, the dispersibility of a near-infrared ray absorbing dye in a resin is improved, the coated film appearance of the near-infrared ray absorption layer is improved, and particularly, pits due to fine bubbles, recesses due to the adhesion of foreign matters, and repulsion at the drying step are prevented. Further, according to the localization of a surfactant by bleeding out on the surface due to heating at applying and drying, when a surfactant having a low HLB is added, not only durability is improved, but also slidability is imparted to the surface of a near-infrared ray absorption layer. For this reason, there is the advantage that, even when surface irregularities are not formed on a near-infrared ray absorption layer or on the opposite side thereof, handling property becomes better, and winding up into a roll becomes easy (see page 55, the last paragraph in the original specification).

In the instant invention, it is important that a surfactant is contained in the near-infrared ray absorption layer at an amount of not smaller than 0.01% by mass and not greater than 2.0% by mass. When the amount of surfactant contained is small, coated film appearance and slidability may become insufficient in some cases. On the other hand, when the amount of surfactant contained is great, the near-infrared ray absorption layer absorbs moisture, so that the deterioration of the dye may be promoted in some cases (see page 57, the last paragraph in the original specification).

When HLB is low, the surface becomes water-repulsive because the surfactant bleeds on the surface of the near-infrared ray absorption layer, so that the deterioration of a dye caused by moisture can be suppressed, and temporal stability of the dye is increased.

For the reasons stated above, instant claims 1 and 13 limit the HLB in the surfactant and the amount to be used. That is, in the present invention, the surfactant is used to ensure not only coatability but also temporal stability of the dye. On the other hand, there is no description about such finding in the invention of Iwato *et al.* For this additional reason, the examiner's rejection under 35 U.S.C. 102(b) should be withdrawn.

As a third reason for withdrawing the rejection, it is noted that the examiner has not met the requirement that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See MPEP 2131. The examiner has picked and chosen from various disclosures in the specification of Iwato *et al* to cobble together an anticipation rejection. It is noted that in at least one claimed embodiment of the instant invention, diimmonium dye is used as a light-heat converting agent. Further, a fluorochemical surfactant having claimed properties is used to, *inter alia*, establish better coatability. The examiner's rejection fails to set forth that a combination such as set forth in Applicant's claimed embodiments is necessarily present in Iwato *et al.* The examiner's rejection does not meet the "complete detail" requirement set forth in MPEP 2131; thus, it is respectfully submitted that the rejection should be withdrawn.

Claim Rejections Under 35 U.S.C. §103

The examiner has rejected the remainder of the claims over Iwato *et al* in view of various references, *i.e.*, Kuwabara, Sato *et al.*, Taki *et al.*, Oya, Moriwaki *et al.*, Kumano *et al.*, Kubo, Ogawa *et al.*, and Iwasaki *et al.* None of these references cure the infirmities of Iwato *et al* as set

forth above. Furthermore, it is noted that a claimed embodiment of the present invention relates to a film which absorbs near-infrared rays released from a plasma display by being placed on the surface of a plasma display. Accordingly, the field of the present invention is different from that of Iwato *et al.*, whose invention relates to an image forming material and requires the alkali developing solubility. The examiner's hindsight rationales for improving a plasma display (see, *e.g.*, paragraphs 7 and 8) simply cannot properly apply to the positive-light-sensitive image forming material of Iwato *et al.* Furthermore, none of the references, in any proper combination, anticipate, or render obvious, each and every element of independent claims 1, 11, 12, 13, 17, and 20, let alone, the dependent claims. The examiner's rejection of independent claims 11, 12, 17, and 20 fail to address the deficiencies of Iwato *et al.* pointed out above, *e.g.*, transparency, use of a surfactant having a particular property in a particular amount, and the use of a particular combination of elements. It is thus respectfully submitted that the examiner's rejection should be withdrawn, as a *prima facie* case of obviousness has not been made.

CONCLUSION

Applicant asserts that all of the stated grounds of rejection have been properly traversed. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

In the event the filing of this paper is deemed not timely, applicant's petition for an appropriate extension of time. The petition fee, if needed, can be charged to deposit account number 11-0600.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Kenyon & Kenyon Deposit Account No. **11-0600**.

The Examiner is invited to contact the undersigned at the telephone number below to discuss any matter concerning this application.

Respectfully submitted,

Applicant: Kenichi MORI, *et al.*
Serial No.: 10/567,761
Response to Office Action mailed September 27, 2007

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